

### **REMARKS**

Claims 1 - 21 are pending in this application. In the Office Action, the Examiner rejected claims 1-6, 8, 10-15, 17, and 19 under 35 U.S.C. § 102(e) as anticipated by United States Patent No. 5, 819,092 to Ferguson et al. The Examiner also rejected claims 7, 9, 16 and 18 under §103(a) as unpatentable over Ferguson et al in view of United States Patent No. 6,323,952 to Blower, Jr. et al. Claims 1-21 also stand rejected under § 101 and claim 19 is rejected under 35 U.S.C. 112 6th paragraph. Applicants respectfully traverse these rejections.<sup>1</sup> Applicants believe that at least some of the rejections should be reconsidered and withdrawn prior to appeal.

### **Amendment to Claim 19**

The Examiner rejected claim 19 under 35 U.S.C. § 112 6th paragraph and requested the Applicants to state whether they intend claim 19 to invoke 35 U.S.C. 112 6th Paragraph. (Office Action p. 4.)

Applicants elect not to invoke 35 U.S.C. § 112 6th paragraph. The Examiner invited Applicants to either amend claim 19 or explain why 35 U.S.C. § 112 6th paragraph should not be invoked.

Applicants have amended claim 19 to replace "means" with --logic processor--.

### **Request for Clarification**

While Applicants acknowledge that the Examiner is not required to respond to this after-final communication, Applicants submit that a substantive response is appropriate in this instance because the Final Rejection contains facially apparent deficiencies in at least some of the objections. Accordingly, to clarify the record for appeal, Applicants respectfully request that the Examiner provide a Supplemental Office Action that clarifies or withdraws some or all of the rejections.

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<sup>1</sup> Applicants disagree with the Examiner's rejection under 35 U.S.C. §101, but understand the Examiner's position, so clarification is not sought on this rejection. Applicant will address that issue in Applicant's next substantive response or on appeal.

### Rejections Under 35 U.S.C. § 102

As a preliminary matter, Applicants do not claim exclusive rights in indicia coding *per se*. To the contrary, Applicants claims are directed to a method, system, and computer program for identifying various components of a system for building, management, and support purposes using indicia coding (i.e. color, shading, or texture). One embodiment is shown in Figs 23A-F (formerly Fig 1-M).

Claim 1 recites the steps of:

(a) displaying a pictorial representation of a system including a plurality of components for building other components, managing the system and its components, and supporting other components of the system;

(b) presenting information relating to building the components of the system by indicia coding the components on the pictorial representation to indicate which components may be used to build other components;

(c) presenting information relating to managing the components of the system by indicia coding the components on the pictorial representation to indicate which components may be used to manage the system and its components; and

(d) presenting information relating to supporting the components of the system by indicia coding the components on the pictorial representation to indicate which components may be used to support other components of the system.

The Examiner rejected claim 1 under section 102 as being anticipated by Ferguson et al (5,819,092).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (quoting Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." MPEP § 2131 (quoting Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

Applicants submit that the Examiner has not met the burden of showing where each element is taught in the cited reference. Applicants acknowledge the Examiner's citations to the reference on page 5 of the final office action, but respectfully submit that those statements do not make the required showing and are inconsistent with the Examiner's statements elsewhere in the office action.

The Examiner stated that Ferguson et al (5,819,092) discloses:

- a) displaying a pictorial representation of an existing system including a plurality of components, see figures 3a, 7-13, also column 19, line 42 - Column 20, line 18;
- b) presenting information related to building the components of the existing system by indicia coding the components on the pictorial representation, see figure 3a (315, 320, 330);
- c) conveying information relating to managing the components of the existing system by indicia coding the components on the pictorial representation, see figure 3a (317);
- d) presenting information relating to supporting the components of the existing system by indicia coding the components on the pictorial representation, see figure 3a (340, 362).

(Office Action, pp. 4-5.)

In response to Applicant's arguments, the Examiner stated that "The icons/displays of Ferguson et al ('092), see figure 7 and 8 which refer to the screens of figures 15 and 16 are seen to be indicia coding/pictorial representation of the components of the system claimed. The management of the components is performed through the manipulations of the document's appearance of figure 3a." (Office Action p. 2)

It is not clear whether the Examiner is finding the claim elements in figure 3a, in figure 7 and 8, or figures 15 and 16 of Ferguson. Applicants request clarification as to exactly where Ferguson teaches presenting information relating to building, managing, and supporting the components of the existing system by non-textual indicia coding the components on the pictorial representation. Which figure is the Examiner taking to be a pictorial representation? What is the non-textual indicia coding on the pictorial

representation? How does the indicia coding present information related to building, managing, and supporting the components?

### Rejections Under 35 U.S.C. § 103

The Manual of Patent Examining Procedure (MPEP) requires that three basic criteria must be met to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP § 2142 (emphasis added.)

The Examiner rejected claims 7, 9, 16, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Ferguson et al (5,819,092) in view of Blower, Jr. et al (6,323,952). (Office Action, p. 7.) The Examiner relied on Blower to show texture, color, or shading coding and relied on Ferguson for the remaining elements of the claims.

Applicants request that the Examiner clarify where the Examiner finds the motivation to combine the references. Applicants further request that the Examiner explain which part of Ferguson the Examiner is combining with Blower to teach all the claim limitations, as required by MPEP § 2142.

### SUMMARY

In summary, each of claims 1-21 is in condition for allowance. The final rejection is facially deficient for failure to set forth a prima facie showing of anticipation or obviousness. Applicants respectfully request a supplemental action or a notice of allowance.



Respectfully submitted,  
Merchant & Gould P.C.  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903  
(612) 332-5300

Date:

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Name:

Jeffrey P. Cook ✓  
Reg. No. 48,649

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